

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

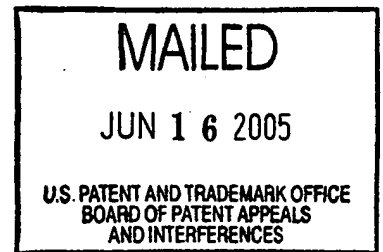
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL WAYNE BROWN,
KELVIN RODERICK LAWRENCE and MICHAEL A. PAOLINI

Appeal No. 2005-0750
Application No. 09/560,320

ON BRIEF



Before THOMAS, GROSS, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15, 16, 18-26 and 38, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to managing home inventory. An understanding of the invention can be derived from a reading of exemplary claim 15, which is reproduced as follows:

15. A method for managing inventory, said method comprising the steps of:

receiving food-related inventory preferences for each of a plurality of users at a controller for a particular storage area that monitors current food-related inventory in said particular storage area;

receiving food-related inventory preferences for a particular user from among said plurality of users at said controller from a personal electronic memory digital data storage device carried on the person of said particular user proffered by said particular user at said controller;

adjusting a current database of intended food-related inventory for said particular storage area at said controller according to said food-related inventory preferences; and

determining a selection of food-related items from among said database of intended inventory items that are absent from said particular storage area, such that food-related inventory that is intended for said particular storage area is managed.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sone	6,204,763	Mar. 20, 2001 (filed Mar. 22, 1999)
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Salvo et al. (Salvo)	6,341,271	Jan. 22, 2002 (filed Nov. 13, 1998)
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Gralla, "How the Internet Works", Millennium Ed., Que Corporation, Aug. 1999.

White, "How Computers Work", Millennium Ed., Que Corporation, Sept. 1999.

Derfler, et al. (Derfler), "How Networks Work", Millennium Ed., Que Corporation, Jan. 2000.

Claims 15, 16, 18-26 and 38 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 15, 16, 18-25 and 38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Sone, or in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sone.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sone in view of Salvo¹.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed March 17, 2004) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed November 24, 2003) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but

¹ In the remarks, the examiner (answer, page 24) additionally relies upon three textbooks: How Computers Work; How Networks Work, and How the Internet Works, to support the examiner's finding of basic knowledge and common sense with respect to the internal components of personal computer 50, in accordance with In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434-1435 (Fed. Cir. 2002). However, for the reasons set forth in our decision, these additional references have not been addressed because of other deficiencies of Sone.

chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of written description, anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we reverse, essentially for the reasons set forth by appellants. We note at the outset, appellants' assertion (brief, page 5) that claims 15, 16, 18-26 and 38 stand or fall together, and (brief, page 6) that claim 15 is exemplary. Accordingly, we select claim 15 as representative of the group of claims rejected under 35 U.S.C. § 112 first paragraph; under 35 U.S.C. § 102(e), and 35 U.S.C. § 103(a) as being anticipated or obvious over Sone. In addition, as claim 26 has been separately rejected under 35 U.S.C. § 103(a)

as being obvious over Sone in view of Salvo, we will separately address claim 26, because procedurally, appellants are entitled to consideration of at least one claim for each separate rejection.

We begin with the rejection of claim 15 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

The issue before us (answer, page 14) is whether the originally filed disclosure provides support for the language "carried on the person of the particular user." The examiner acknowledges (answer, pages 10 and 11) that "'the invention claimed does not have to be described in ipsis verbis in order to satisfy the description requirement of § 112' (underlining added)." In addition, the examiner asserts (answer, page 11) that "'a personal electronic memory digital data storage device carried on the person of said particular user" may be obvious in view of Applicant's disclosure, this nevertheless does not satisfy the written description requirement." The examiner is correct that the issue is not whether the language in question would have been obvious. The issue is whether appellants were in possession of the claimed invention at the time of filing of the application.

Appellants assert (brief, page 9) that "[a]s is well known by those skilled in the art, a SmartCard or 'ibutton' is designed

to be carried on the person of a user, and therefore there is clearly inherent support in the specification for the claim limitation of *'carried on the person of said particular user'.*"

Appellants assert that the specification (page 16) discloses that personal storage device 60 is explicitly specified as, but not limited to a palm-top computer, a PDA, a cell phone or a notebook computer. It is argued (*id.*) that these types of electronic storage devices are well known by those skilled in the art as devices to be carried on the person of the user. Appellants provide a Dictionary definition² of a notebook computer as "[s]ee portable computer," and additionally assert (brief, page 10) that "[a]lthough the specification does not explicitly state that the SmartCard, ibutton, notebook, PDA or cell phone is carried by a user, Appellant's [sic] believe they have shown above that such an element is inherent in such devices."

From the arguments presented, we find that the issue before us relates to inherency as applied to the issue of written description. MPEP, Eighth Edition, Revision 1, Feb. 2003³,

² IBM Dictionary of Computing.

³ This Revision of the MPEP was in effect at the time the brief and answer were written.

§ 2163.07(a) is directed to inherency as it relates to written description. Section 2163.07(a) recites:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). 'To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient' *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

From our review of the record, and the guidance provided by the MPEP, we find that at least the smart card, notebook computer, palm-top computer, cell phone and PDA inherently provide basis in the originally filed disclosure for the claim language "carried on the person of said particular user" as asserted by appellants. Although we agree with the examiner's statement of the law, we find the examiner's interpretation of the law to the facts of this appeal to be misplaced. The

examiner is correct in the statement (answer, page 15) that "[t]he test for inherency thus becomes: was the inherent element necessarily present in Applicants' disclosure?" However, the examiner is incorrect in the statement "[i]n other words, do those products necessarily have to be carried on the person of said particular user? The answer is simply no. They do not necessarily have to be carried on the person of said particular user. While personal computers, laptop computers, notebook computers, and portable computers may be carried on a user, they do not necessarily have to be carried on the person of said particular user."

To be inherent, the inherent element must necessarily be present in appellants' disclosure. In the appeal before us, the Smartcard, notebook computer, palm-top computer, cell phone and PDA are explicitly disclosed in appellants' specification, as originally filed. Because these items are known to be carried by a user, the language that they are carried by the user is inherent from appellants' original disclosure. The issue is not whether these items can be placed on a desk or table and not be carried by a user, but rather that an artisan would recognize that these items are meant to be carried by a user. Thus, we find that the examiner has confused the items being necessarily

Examiner
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was!

Where does this come from? What case?

present in the original specification, with the items necessarily being carried by the user at all times, without being at a location other than "carried on the person of the particular user." In other words, "necessarily present" in the reference is not the same as the "element must be carried by the user at all times." So? this sentence is useless!

From all of the above, we find that the examiner has failed to establish a prima facie case of lack of written description for the language "carried on the person of said particular user." Accordingly, the rejection of claims 15, 16, 18-25, and 38 under 35 U.S.C. § 112, first paragraph is reversed.

We turn next to the rejection of claims 15, 16, 18-25 and 38 under 35 U.S.C. § 102(e) as being anticipated by Sone, or in the alternative under 35 U.S.C. § 103(a) as being obvious over Sone.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may

result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In addition, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner asserts (answer, pages 16 and 17) that "if the Board finds the 'personal electronic digital data storage device carried on the person of said particular user' is inherent in Applicants' disclosure, . . . the Board must also find the same features inherent in Sone." In an appendix to the answer, the examiner provides a one-to-one comparison between claim 15 and the disclosure of Sone. In particular, the examiner finds that personal computer 50 has a removable drive, a diskette drive,

etc. and that quantity thresholds are but one of many preferences. In addition, the examiner (answer, page 18) brings to our attention the disclosure of Sone that in the second embodiment shown in figure 4, instead of a built-in dedicated computer, an interface 43 is provided that makes sensors 31 compatible with personal computer 50.

Appellants take issue (brief, page 6) with the examiner's finding that the ice cream in the refrigerator of Sone reads on the claimed "*food-related inventory preferences*" because "*inventory preferences*", are described in the specification as a database of electronic preferences. It is argued that the reasonable interpretation of the claim by an artisan is that a given food item in the refrigerator of Sone does not represent a database of "preferences" as claimed.

From our review of claim 15, we find that the claim recites, inter alia, "receiving food-related inventory preferences for a particular user from among said plurality of users at said controller from a personal electronic memory digital data storage device carried on the person of said particular user proffered by said particular user at said controller." Claim 15 additionally recites that the controller monitors the food-related inventory

preferences in a particular storage area. From the language of the claim, we find that the "food-related inventory preferences" are stored in a database monitored by the controller, but that the phrase does not require the database itself to be part of the food-related storage preferences. In addition, as to whether the ice cream in the refrigerator of Sone can be considered to meet the claimed food-related inventory preference, we note that the specification (page 14) discloses "[f]ood-related inventory preferences may include specified food preferences for a user. . . ." From this disclosure and the language of claim 15, we find that claim 15 is drafted broadly enough for the ice cream 35 (figures 2 and 4) to read on the claimed food-related inventory preferences, because a user can have a preference of having ice cream as one of the items in the refrigerator.

As to appellants' assertion (brief, page 7) that the claimed "*food-related inventory preferences*" are received *'at said controller'* from the *'a personal electronic memory digital data storage device'*" is not met by Sone, we find that in the second embodiment of Sone found in figure 4, built-in computer 26 of figure 2 is replaced by personal computer 50. From the disclosure of computer 50 being a personal computer, we find that

the personal computer, from appellants' dictionary definition of
a notebook computer (brief, page 10), can be a notebook computer,
which is carried by a user. However, figure 4 of Sone, which
includes personal computer 50, either connects to the
refrigerator through interface 43 or communicates directly with
sensors 31 (col. 4, lines 5-12).

Claim 15 requires a controller that monitors the food-
related inventory preferences in a storage area, and also
requires that the preferences are received at the controller from
the personal electronic memory digital data storage device, and
that the preferences are proffered at the controller by the user.
In figure 4 of Sone, only an interface exists between the
personal computer and the sensors, or there is direct
communication between the personal computer and the sensors.
There is no disclosure of a controller for receiving the food-
related inventory preferences from the personal electronic memory
digital data storage device, because in Sone, the controller is
in the computer. Claim 15 is not met by a disclosure of the
controller in the computer receiving the food-related inventory
preferences from the computer. The claim requires a controller
in addition to the personal data storage device. Nor is claim 15

met by removing a storage device from the computer, reinstalling the storage back in the computer, and transmitting the food-related inventory preferences to the controller in the computer because the controller monitors a storage area. A storage device, such as a floppy drive, is not a controller. Although Sone refers to the interface 43 performing processing (col. 7, line 56) the processing only relates to making the sensors compatible with the computer 50, and does not disclose or suggest a controller that will receive the food-related inventory preferences.

In addition, we find that Sone does not anticipate claim 15 because Sone is directed to a system for a single household, and does not teach a controller receiving food-related inventory preferences for a particular user among a plurality of users. Moreover, we find that if Sone were modified to be used for multiple households, there would be a separate system, with a separate personal or built-in computer for each refrigerator. We find no teaching or suggestion in Sone, and none has been brought to our attention by the examiner, that would have suggested providing an integrated system for handling plural refrigerators, other than from appellants' disclosure. In addition, we find no

teaching of the controller in the computer recognizing different users within a single household, but rather receives and fills all food-related inventory preferences inputted at the refrigerator.

Thus, we find from all of the above that the examiner has failed to establish that Sone either anticipates or renders obvious the limitations of claim 15. Independent claim 38 contains similar language as claim 1 with respect to the controller.

Accordingly, the rejection of claims 15, 16, 18-25 and 38 under 35 U.S.C. § 102(e) or in the alternative under 35 U.S.C. § 103(a) is reversed.

We turn next to the rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Sone in view of Salvo. We cannot sustain the rejection of claim 26 because the examiner has not shown that Salvo makes up for the basic deficiencies of Sone. Accordingly, the rejection of claim 26 under 35 U.S.C. § 103(a) is reversed.

To summarize, the decision of the examiner to reject claims 15, 16, 18-26 and 38 under 35 U.S.C. § 112, first paragraph, is reversed. The decision of the examiner to reject claims 15, 16, 18-25 and 38 under 35 U.S.C. § 102(e) or alternately under 35 U.S.C. § 103(a) is reversed. The decision of the examiner to reject claim 26 under 35 U.S.C. § 103(a) is reversed.

JAMES D. THOMAS
Administrative Patent Judge

Anita Pellman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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Appeal No. 2005-0750
Application No. 09/560,320

Page 19

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